

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. ADAMS

Appeal No. 2002-1407
Application 09/157,995

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, all of the claims pending in this application.

Appellant's invention is directed a method of conducting a game of chance and to a gaming device implementing that method. Independent claims 1, 14 and 17 are representative of the subject

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matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Marsh	GB 2180682A	Apr. 1, 1987
Pickardt et al. (Pickardt)	GB 2201821A	Sep. 7, 1988

Advertisement for "Double or Nothing" slot machine distributed by Bally Distributing Company (Bally), page 267, 1984

Claims 1 and 4 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bally in view of Marsh.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bally in view of Pickardt.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 12, mailed June 12, 2001) and examiner's answer (Paper No. 19, mailed February 25, 2002) for the reasoning

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in support of the rejections, and to appellant's brief (Paper No. 17, filed November 28, 2001) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

The examiner's rejection of claims 1 and 4 through 20 under 35 U.S.C. § 103(a) as being unpatentable over Bally in view of Marsh (final rejection, page 2) recognizes that Bally discloses a gaming device and method of conducting a game of chance including placing a wager to enable initiation of play on a primary gaming unit, displaying an indicia set randomly selected from a plurality of possible indicia and wherein at least one of said indicia of the displayed set is a winning indicia resulting in crediting of winnings from the primary game, and providing at least one opportunity for the player to change those winnings through play on a secondary "Double or Nothing" gaming unit

giving the player a 50/50 chance to double the winnings from the primary gaming unit or lose it all. What the examiner finds lacking in Bally with respect to the independent claims on appeal (i.e., claims 1, 14 and 17) is any disclosure or teaching of wagering "less than all of said winnings" or prize from the primary gaming unit.

To account for the above difference, the examiner turns to Marsh urging that it teaches a gaming unit and method of conducting a game of chance wherein a wager is made and a player has the opportunity to change the winnings of one game by wagering less than all of the primary winnings on a second game or prize opportunity in a game of the same type (lines 41-61), thereby allowing continuous play of the game as long as the player has credits to wager. From the combined teachings of Bally and Marsh, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention "to modify the invention of Bally with the invention of Marsh by adding the feature of wagering less than all of the primary winnings in order to increase the players' chances of winning" (final rejection, page 3).

Like appellant, we find no basis in the combined teachings of Bally and Marsh for modifying the "Double or Nothing" gaming device and method of Bally in the manner urged by the examiner. In that regard, we share appellant's view that the examiner is using the hindsight benefit of appellant's own disclosure to pick and choose elements or concepts from the applied references, and then selectively combine the chosen disparate elements or concepts in an attempt to reconstruct appellant's claimed subject matter. However, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

While it appears that one of ordinary skill in the art could modify a gaming device similar to that in Bally in the manner posited by the examiner, we find no suggestion, reason or incentive in the applied prior art itself for making any such modification. In that regard, we observe that the mere fact that some prior art reference (e.g., Bally) may be modified in the manner urged by the examiner does not make such a modification

obvious unless the applied prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir 1984). Here, the Bally advertisement emphasizes that the 50/50 chance to double up on each spin of the "Double or Nothing" slot machine therein is "attractive to big-win slot machine players" and provides "a tantalizing teaser that ensures continuous play" and big earnings for the casino. Thus, we share appellant's view expressed on pages 8-11 of the brief that the potential rewards, as well as the risks, associated with each spin of the auxiliary double-or-nothing reel in Bally are significant, and are integral aspects of the operation and appeal of the slot machine gaming device in the Bally advertisement. The high stakes/high risk thrill involved in the play of Bally's secondary bonus game defines the very essence of the Bally disclosure and it is this aspect of the game that is predominately marketed as a unique gaming feature which will attract players.

Accordingly, the examiner's attempt to modify the Bally gaming device by lessening either the rewards or the risks associated with the auxiliary bonus game, such as by wagering less than all of the winnings from the primary game, in our

opinion, is contrary to the essential teachings of Bally and would change a fundamental principle of operation of the Bally gaming device. In our view, this significant disincentive for modifying Bally in the manner urged by the examiner is not overcome by the mere disclosure in Marsh of the concept of a game feature wherein less than all the winnings of a prior game can be wagered in an attempt to attain another prize in a subsequent play of a game of the same type. Marsh appears to be drawn to a method for allowing continuous play of a primary game based on "credits" won, without the deposit of any additional money. Marsh does not teach or suggest that less than all of a prize or winnings can be apportioned in any type of secondary bonus game or device, much less a secondary bonus game/device of the particular type taught in Bally.

Simply stated, one of ordinary skill in the art would not have found any teaching, suggestion, or incentive in Marsh for attempting to employ the wagering scheme of Marsh's continuous play game to change the high stakes/high risk "Double or Nothing" bonus wagering scheme of the slot machine device of Bally. In

fact, it would appear to us that any such modification of the gaming device of Bally would be antithetical to the entire teachings and suggestions found in the Bally advertisement.

Since we have determined that the teachings and suggestions found collectively in Bally and Marsh would not have made the subject matter as a whole of independent claims 1, 14 and 17 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 4 through 13, 15, 16 and 18 through 20 under 35 U.S.C. § 103(a) on that same basis will likewise not be sustained.

We have additionally reviewed the examiner's rejection of claims 2 and 3 under 35 U.S.C. § 103(a) based on Bally and Pickardt. However, as pointed out by appellant on page 19 of the brief, claims 2 and 3 depend from independent claim 1 and likewise include the limitation regarding at least one opportunity to change "less than all of said winnings" of a primary game through play on a secondary gaming unit. While the examiner's rejection attempts to supply a deficiency in Bally by

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relying on a teaching in Pickardt addressing the added limitations found in dependent claims 2 and 3 on appeal (i.e., a rotatable disc or wheel used in the secondary game), the examiner has made no attempt in this rejection to account for the limitation both the examiner and appellant acknowledge is missing in Bally from independent claim 1 on appeal regarding wagering less than all of the winnings of a primary game. Neither Bally nor Pickardt address this limitation found in appellant's claim 1 and, by their dependency, in claims 2 and 3. Thus, it is clear that the examiner has not set forth a *prima facie* case of obviousness with respect to dependent claims 2 and 3, and the rejection of those claims under 35 U.S.C. § 103(a) will not be sustained.

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In view of the foregoing, the examiner's decision rejecting claims 1 through 20 of the present patent application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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JEFFREY V. NASE)	
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